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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,881	09/11/2003	Yoel Wazana	28179-7	5001

33417 7590 02/05/2008  
LEWIS, BRISBOIS, BISGAARD & SMITH LLP  
221 NORTH FIGUEROA STREET  
SUITE 1200  
LOS ANGELES, CA 90012

EXAMINER
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ELVE, MARIA ALEXANDRA

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/659,881

### Applicant(s)

WAZANA ET AL.

### Examiner

M. Alexandra Elve

### Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/11/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

Claims 6 & 15-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant has used computer programming and computer instructions; these are non-statutory.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "gimbal" in claims is used by the claim to mean "clamp or holder", while the accepted meaning is "rotation device." The term is indefinite because the specification does not clearly redefine the term.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-11 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Araki (USPN 6,223,010).

Araki discloses a resin cartridge with contacts, which is disassembled.

Applicant's claim recitations regarding the method of forming a product, relate only to the method of producing the claimed product, which does not impart patentability to the product claims. Note that determination of patentability is based on the product itself, In re Brown 173 USPQ 685, 688 and In re Fessmann 180 USPQ 324, and the patentability of a product does not depend its method of production, In re Pilkington 162 USPQ 145, 147; see also In re Thorpe 227 USPQ 964 (CAFC 1985). Note that it is Applicant's burden to prove that an unobvious difference exists, In re Marosi 218 USPQ 289, 292-293 (CAFC 1983), and Applicant must show that different methods of manufacture produce articles having inherently different characteristics, *Ex parte Skinner* 2 USPQ 2d 1788.

Claims 7-11 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baley (USPN 5,676,794).

Baley discloses a plastic reconditioned printer cartridge with contacts.

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Applicant's claim recitations regarding the method of forming a product, relate only to the method of producing the claimed product, which does not impart patentability to the product claims. Note that determination of patentability is based on the product itself, In re Brown 173 USPQ 685, 688 and In re Fessmann 180 USPQ 324, and the patentability of a product does not depend its method of production, In re Pilkington 162 USPQ 145, 147; see also In re Thorpe 227 USPQ 964 (CAFC 1985). Note that it is Applicant's burden to prove that an unobvious difference exists, In re Marosi 218 USPQ 289, 292-293 (CAFC 1983), and Applicant must show that different methods of manufacture produce articles having inherently different characteristics, *Ex parte Skinner* 2 USPQ 2d 1788.

Claims 7-11 & 14 rejected under 35 U.S.C. 102(b) as being anticipated by Sekine (USPN 6,788,908).

Sekine discloses a plastic cartridge with contacts.

Applicant's claim recitations regarding the method of forming a product, relate only to the method of producing the claimed product, which does not impart patentability to the product claims. Note that determination of patentability is based on the product itself, In re Brown 173 USPQ 685, 688 and In re Fessmann 180 USPQ 324, and the patentability of a product does not depend its method of production, In re Pilkington 162 USPQ 145, 147; see also In re Thorpe 227 USPQ 964 (CAFC 1985). Note that it is Applicant's burden to prove that an unobvious difference exists, In re Marosi 218 USPQ 289, 292-293 (CAFC 1983),

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and Applicant must show that different methods of manufacture produce articles having inherently different characteristics, *Ex parte Skinner* 2 USPQ 2d 1788.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 & 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Araki (USPN 6,223,010) in view of Basista et al. (USPN 6,609,044) and Eckard et al. (USPN 6,464,327).

Araki discloses a resin product with the method and apparatus used for disassemble. The cartridge is cut with a laser.

Araki does not teach the use of a computer or a gimbal (that rotation of the part).

Basista et al. discloses the use of a computer and an associated program for laser cutting.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a computer and cutting program as taught by Basista et al. in the Araki system because it would ensure cutting accuracy and decrease processing time.

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The provision of mechanical or automated means to replace a manual activity was held to have been obvious. In re Venner 120 USPQ 192.

Eckard et al. discloses the refurbishment of an inkjet cartridge. The gimbal action rotates the product for processing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a rotation device, as taught by Eckard et al. in the Araki system because of the enhanced ease of product handling during the disassembly process.

With respect to applicant's predetermined laser power and speed these are design choices, dependent on the material chosen. The types of materials are a choice in design and substitution of known equivalent structures may be made. In re Kuhle 188 USPQ (CCPA 1975), In re Ruff 118 USPQ 343 (CCPA 1958).

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 7:30-4:00 Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on 571-272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 4, 2008.

/M. Alexandra Elve/  
M. Alexandra Elve  
Primary Examiner 1793